

R E M A R K S

Claims 1-7, 11-13, 15 and 18-20 stand allowed.

The claims have been further amended to improve their form and better define the invention. Applicant has taken particular care not to change the scope of the independent claims or raise new issues in any of the claims of such a nature as to require the Examiner to make a further search or reconsider the claims in a manner to prevent the entry of such amendments at this time. It is therefor respectfully requested that the amendments be entered to place the application in condition for allowance or better condition for Appeal.

The specification has been amended to overcome the rejection of the Examiner set forth in the first two paragraphs of page 2 of Paper No. 5, it being noted that while the Board of Appeals in Appeal No. 499-28 stated that contrary to the Examiner's position, whether or not applicant's application is labelled a continuation-in-part.... "is not controlling as to entitlement to the earlier filing date", etc.

It is noted that claims 1-7, 11-13, 15 and 18-20 stand allowed while claims 8-10, 14, 16 and 17 are rejected.

Turning first to the rejection of claims 8, 9, 10 and 14 under 35 USC 102 [a] as anticipated by Fraser. In support of the rejection, the Examiner relies upon the fact that the claim limitations specify that the recording member is a "rectangular wall" [claim 8], a "sheet of thin, elongated rectangular recording material" [claims 9 and 10], and a "flat sheet-like member" [claim 14]. The Examiner then indicates that such wording precludes applicant from relying

on his earlier application Serial No. 225,173 for a prior date.

Traversal is requested and believed to be proper in that substantially all forms of tape, including magnetic tape or tape containing printed indicia, such as disclosed in applicant's 1962 patent application Serial No. 225,173, are formations of flat sheet material derived from a larger sheet of flat sheet material. It is noted that there was no limitation in the claims as to the size of the sheet material [eg-its width or length] and therefor applicant cannot understand why the reference to a record member in the form of a thin, flat tape or strip as a "flat sheet material" is not correct.

However, it is noted that applicant amended claim 8 in his response to the Office Letter of August 30, 1985/<sup>is drawn</sup> in such a manner as to more specifically read on magnetic or printed tape of the type defined in his earlier application Serial No. 225,173 to define that the object set forth in [allowed] claim 1:

"has a rectangular wall along which wall said recording is effected".

Certainly the Examiner cannot deny that an elongated section of magnetic tape or strip of electro-optical recording material containing electro-optically scannable indicia, does not come within the purview of the wording of claim 1 when the object is in the shape of a flat sheet material as now defined in amended claim 8, and as disclosed in applicant's prior patent application SN 225,173 which applicant has a right to rely on for support even though this application may not be defined as a continuation-in-part therefrom.

It is submitted that all tapes, regardless of their length, unless they are cut on the bias ( a disclosure not present in the instant application and not practiced by those skilled in the art of fabricating and winding record tapes) are

sheet material as set forth in claim 8 and that such claim is allowable as is its parent claim 1.

Literally, claim 14 reads directly on any form of magnetic recording material or other recording material having an elongated shape which contains a rectangular wall along which recording is effected. In his application Serial No. 225, 173, applicant certainly disclosed therein [see FIGS. 3, 8, 9, etc.] the use of an elongated rectangular record member containing one or more record tracks having indicia which extend:

"parallel to an edge of said rectangular wall of said object".

The Examiner's attention is directed specifically to the third paragraph from the end of the Specification of Serial No. 225,173 which provides ample support for the subject matter found in claims 8, 9 and 10.

Claim 9 depends from claim 1 and, as amended herein, refers to the object as:

"made of a thin, elongated rectangular recording material of constant thickness and width...."

Literally, as amended herein, claim 9 reads on the magnetic and electro-optical record members set forth in applicant's prior application Serial No. 225,173.

Similar arguments are presented traversing the rejection of claim 10, which depends from claim 9 and adds to the method defined in claim 9 that the controlled relative movement between the beam and the object is:

"effected to record said indicia:

"parallel to an edge of said object"

It is submitted that the method defined in dependent method claim 10 is certainly disclosed in applicant's Serial No. 225,173 which, in view of the allowance of claim 1 from which claim 10 indirectly depends, should permit claim 10 to be allowed.

Accordingly, since independent claim 1, from which claims 8-10 directly and indirectly depend, has been allowed and applicant's literal reading of the limitations found in these claims on the disclosure found in applicant's application Serial No. 225,173, properly indicates that the language of these claims, as amended herein, finds support in said earlier application, dependent method claims 8-10 should be allowed and their allowance is respectfully requested together with the other claims allowed.

Claim 16 has been further amended herein and is belived to have patentably differentiated over the prior art defined by Lee, Jr. et al prior to such amending. The synchronizing signal generated by the reference is not the equivalent of the "recording cycle initiating control signal" defined in claims 16 and 17, nor does it trigger the reproduction of select information from a memory as set forth in claim 16. Nor does the reference teach or suggest the generating of the synchronization or triggering pulse upon "detecting when...predetermined relative positioning is effected... between (a)..radiation beam generating means and ...(an)...object" as set forth in claim 16 and broadly defined by the method set forth in allowed claim 1.

Lee, Jr. et al provides an thermoplastic information storage system in which an input electric signal (in analog or digital form) is fed to a coding translation matrix 11...wherein such signal may be stored temporarily". Such matrix is, in effect, a buffer interface such as a shift register or an ultrasonic delay line which reads out all the information it receives on an input 13 in a processed or coded form in response to the operation of a synchronizing signal generator 19. The latter does not operate to detect the position or appearance of the record member or storage medium 35 of the reference. Therefore the reference fails to disclose or suggest the method step, viz:

" detecting when such predetermined relative positioning is effected between said radiation beam generating means and said object.....and

generating a first recording cycle initiating control signal...upon effecting said predetermined relative positioning..."

In brief, applicant's method defines detecting the presence of an object or the predetermined positioning of the object and a beam generating means and generating a control (upon attaining such predetermined positioning) and employing such control signal to address a memory to effect the reproduction of select information from such memory which is applied to control the beam recording operation to effect the recording of indicia ...across a band-like area of the surface of the object. This method is not disclosed in Lee, Jr. et al and is not obviously derivable therefrom.

Since the method defined in claim 16, as amended herein, is not disclosed in or obviously derivable from Lee, Jr. et al, it is submitted that such claim is patentable thereover and its allowance is requested along with the other claims which have been allowed.

Applicant will soon submit a supplemental amendment under Rule 116 correcting the specification to place it in better form and condition for allowance.

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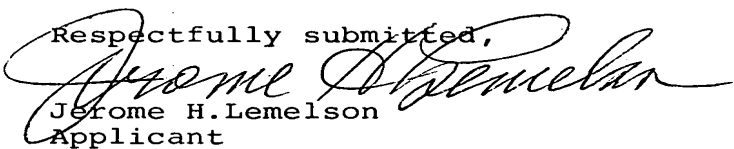
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Please call applicant, if necessary to advance the prosecution and allowance of this application, and notify applicant if new drawings are necessary.

Respectfully submitted,

  
Jerome H. Lemelson  
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CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Post as First Class Mail in an envelope addressed to Commissioner of Patents and Trademarks, Washington, D.C. 20231

ON May 3-1986

JEROME H. LEMELSON

BY: J. Lemelson DATE: 5/3/86